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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/797,047 | 03/11/2004 | Takao Tsubouchi | 2004-0393A | 4686 |
| 513 | 7590 | 02/03/2005 | EXAMINER | |
| WENDEROTH, LIND & PONACK, L.L.P. 2033 K STREET N. W. SUITE 800 WASHINGTON, DC 20006-1021 | | | CARTER, MONICA SMITH | |
| | | ART UNIT | PAPER NUMBER | |
| | | 3722 | | |

DATE MAILED: 02/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Offic Action Summary | Application No. | Applicant(s) |
|-----------------------------|------------------------|---------------------|
| | 10/797,047 | TSUBOUCHI, TAKAO |
| Examiner | Art Unit | |
| Monica S. Carter | 3722 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 11 March 2004.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-20 and 25-28 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-20 and 25-28 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date .
4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I, claims 1-20 in the reply filed on November 02, 2004 is acknowledged.
2. Claims 21-24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on November 02, 2004.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 13-20 recite the limitation "the size" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-8 and 13-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Williamson et al. (5,098,127).

Williamson et al. disclose a magazine comprising generalized pages (14) and printable sheets of specialized pages (34), the specialized pages being attached to the magazine (12), an adhesive side (26) with an adhesive layer and the printable sheets being inherently printed by a conventional printing means since the sheets receive advertising indicia.

Williamson et al. disclose the claimed invention except for the specific arrangement and/or content of indicia (e.g., "the specialized page contains particular content to the specific use of the handbook") set forth in the claim(s). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide any desired indicia on the pages, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of page does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate that is required for patentability.

The limitation of the specialized page being formed by attaching at least part of the adhesive side of the printable sheet to at least one generalized page does not structurally limit the claim. The patentability of a product does not depend on its method

of production. Product-by-Process claims are not limited to the manipulations of recited steps, only the structure implied by the steps. (See MPEP 2113)

Regarding claim 2, the handbook functioning as at least one of an official record and an indication of qualification sets forth the intended use of the handbook. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Regarding claims 3 and 4, the generalized pages being permanently bound together prior to attaching the at least one specialized page does not structurally limit the claim. The patentability of a product does not depend on its method of production. Product-by-Process claims are not limited to the manipulations of recited steps, only the structure implied by the steps. (See MPEP 2113)

Regarding claims 5 and 6, the printable sheet comprises multiple printing spaces (wherein the printing spaces would be located anywhere on the printable sheets) forming corresponding multiple pages of the specialized pages and the adhesive layer (26) being formed on at least a portion of the back of one of the printing spaces (see column 3, lines 59-62).

Regarding claims 7 and 8, see the above rejections to claims 5 and 6. Williamson et al. further disclose at least one fold line (22) disposed along a border between at least two of the printing spaces by which the printable sheet can be folded up into a concertina (see figures 1 and 3) and the adhesive layer being formed on at least a portion of the back of the printing spaces (see column 3, lines 59-62).

Regarding claims 13-16, Williamson et al. disclose the size of the printing space being smaller than that of the generalized pages (as seen in figure 1).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 13-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williamson et al.

Williamson et al. discloses the claimed invention except for explicitly disclosing the size of the printing space and the generalized page. It would have been an obvious matter of design choice to provide any desired dimensions for the printing space and generalized page, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). Further, applicant has failed to disclose that the size of the printing space is critical to the invention.

9. Claims 9-12, 17-20 and 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williamson et al. in view of Hudetz (5,826,914).

Regarding claims 9-12, Williamson et al. disclose the claimed invention except for the at least one printing space being separable from the printable sheet by at least one perforated line.

Hudetz discloses a magazine having a printable insert (10) having perforations (20) for separating a portion (18) of the insert from the remainder of the insert. Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify the printable sheet in the magazine of Williamson to include perforations and a removable section, as taught by Hudetz, to enable the removable portion to be separately used (e.g., postal reply card).

Regarding claims 17-20, Williamson et al., as modified by Hudetz, disclose the claimed invention except for explicitly disclosing the size of the printing space and the generalized page. It would have been an obvious matter of design choice to provide any desired dimensions for the printing space and generalized page, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). Further, applicant has failed to disclose that the size of the printing space is critical to the invention.

Regarding claim 25, Williamson et al., as modified by Hudetz, discloses the claimed invention as set forth in the above rejections to claims 1 and 9-12.

It is noted that the process of forming the specialized page ("formed by removing the detachable...to the generalized page."), does not structurally limit the claim. The patentability of a product does not depend on its method of production. Product-by-Process claims are not limited to the manipulations of recited steps, only the structure implied by the steps. (See MPEP 2113)

Regarding claim 26, the handbook functioning as at least one of an official record and an indication of qualification sets forth the intended use of the handbook. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Regarding claims 27 and 28, the particular content being retrieved from a database and transferred to a printing means does not structurally limit the claim. The patentability of a product does not depend on its method of production. Product-by-Process claims are not limited to the manipulations of recited steps, only the structure implied by the steps. (See MPEP 2113)

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited references disclose booklets.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (571) 272-4475. The examiner can normally be reached on Monday-Thursday (6:00 AM - 3:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

February 1, 2005

Monica S. Carter
MONICA S. CARTER
PRIMARY EXAMINER